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MORGAN & FINNEGAN, L.L.P. 3 WORLD FINANCIAL CENTER NEW YORK, NY 10281-2101				
EXAMINER				
LU, JIPING				
ART UNIT		PAPER NUMBER		
3743				
NOTIFICATION DATE		DELIVERY MODE		
02/05/2009		ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary

Application No.

10/075,552

Applicant(s)

BIRO ET AL.

Examiner

Jiping Lu

Art Unit

3743

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 November 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 34-38 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 34-38 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/CDC)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date _____

DETAILED ACTION

Claim Rejections - 35 USC § 102/103

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
2. Claim 38 is rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Mukai (U.S. Pat. 5,120,394).

Mukai shows in Fig. 1 an exposure apparatus 2 including an optical lens 11 same as claimed. Mukai discloses each and every structural element of an exposure apparatus set forth in claim 38. The claimed phrase "having been rinsed in accordance with the rinsing method as recited in claim 34" is being treated as a product by process limitation; that is, the optical lens is rinsed by the method recited in claim 34. As set forth in MPEP 2113, product by process claims are NOT limited to the manipulations of the recited steps, only to the structure implied by the steps. Once a product appearing to be substantially the same or similar is found, a 35 U.S.C.102/103 rejection may be made and the burden is shifted to applicant to show an unobvious difference. See MPEP 2113. Thus, it appears that the product in Mukai would be the same or similar as that claimed.

3. Claim 38 is rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Kamiya (U.S. Pat. 4,989,031).

Kamiya shows in Fig. 1 an exposure apparatus 20 including an optical lens 4 same as claimed. Kamiya discloses each and every structural element of an exposure apparatus set forth in claim 38. The claimed phrase "an optical lens having been rinsed in accordance with the

rinsing method as recited in claim 34" is being treated as a product by process limitation; that is, the optical lens is rinsed by the method recited in claim 34. As set forth in MPEP 2113, product by process claims are NOT limited to the manipulations of the recited steps, only to the structure implied by the steps. Once a product appearing to be substantially the same or similar is found, a 35 U.S.C.102/103 rejection may be made and the burden is shifted to applicant to show an unobvious difference. See MPEP 2113. Thus, it appears that the product in Kamiya would be the same or similar as that claimed.

4. Claim 38 is rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Tomoharu et al. (JP 11-224839).

Tomoharu et al. shows in Fig. 1 an exposure apparatus 2g including an optical lens 2a-2d, 4a-4b same as claimed. Tomoharu et al. discloses each and every structural element of an exposure apparatus set forth in claim 38. The claimed phrase "an optical lens having been rinsed in accordance with the rinsing method as recited in claim 34" is being treated as a product by process limitation; that is, the optical lens is rinsed by the method recited in claim 34. As set forth in MPEP 2113, product by process claims are NOT limited to the manipulations of the recited steps, only to the structure implied by the steps. Once a product appearing to be substantially the same or similar is found, a 35 U.S.C.102/103 rejection may be made and the burden is shifted to applicant to show an unobvious difference. See MPEP 2113. Thus, it appears that the product in Tomoharu et al. would be the same or similar as that claimed.

Claim Rejections - 35 USC § 103

5. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
6. Claims 34-37 are rejected under 35 U.S.C. 103(a) as unpatentable over Tomoharu et al. (JP 11-224839) in view of Mukai (U.S. Pat. 5,120,394) and Kuzumoto et al (U.S. Pat. 6,616,773)

Tomoharu et al. discloses a rinsing method comprising the steps of accommodating an article 2a-2d, 4a-4b, to be rinsed, into a second container 2g which is disposed inside a first container (room used to house the container 2g), introducing an oxygen gas 10a into the second container 2g, irradiating the article from a light source 1 disposed outside second container, wherein the internal pressure in the second container is higher than the first container, (the second container is pressurized while the article 2a-2d, 4a-4d under irradiation of ultraviolet rays during operation) and introducing a nitrogen gas 8a into the second container 2g and exhausting/discharging (thru 9a) the oxygen gas in the second container 15 to exchange an ambience of the second container same as claimed. The oxygen gas or the ozone gas in the first container is substantially exhausted (thru doors or windows of aforementioned room used to house the second container 2g). During the operation, there will be some N₂ in the ambience. It should be noted that N₂ does exist in ambience or atmosphere. The article is unloaded from the first and second containers after leaving the article in the nitrogen ambience. It is inherent that the article will be unloaded from the first and second containers after rinsing. The second container has a clearance (from the statement of page 3, lines 44-46, it is implicitly disclosed that there is a clearance, otherwise it would mean that the container 15 is perfectly sealed and there would not be a need for maintaining a higher pressure inside) through the first container. The

first gas supplying means 8a, 10a is configured to introduce the rinsing gas into the second container to maintain an ambience in the second container (see page 3, lines 16-17) which ambience is different from that of said first container and also to keep an internal pressure higher than that of said first container (see page 3, lines 44-46). However, Tomoharu et al do not show irradiating the article with ultraviolet rays and introducing a nitrogen gas into the second container and exhausting the oxygen gas or ozone gas in the second container to exchange an ambience of the second container. Mukai teaches a concept of using ultraviolet light generator for irradiating a laser ray (wavelength: 193 nm) over the surface of substrate 11 (col. 5, lines 6-9) and introducing N₂ gas 8, 9 into the inner (second) container. Kuzumoto et al. teach a concept of introducing a nitrogen gas into the second container 1 and exhausting the oxygen gas or ozone gas in the second container to exchange an ambience of the second container (col. 2, lines 33-36 and Fig. 1). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify method of Tomoharu et al to include a step of supplying ultraviolet rays as taught by Mukai and a step of introducing a nitrogen gas to the second container for replacing the oxygen gas or ozone gas in the second as taught by Kuzumoto et al. in order to more efficiently clean the articles inside the second container. With regard to the claimed material of the article to be cleaned, it would have been obvious to one having ordinary skill in the art at the time the invention was made to choose the article with any kind of material, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. In re Leshin, 125 USPQ 416. Regarding claim 37, the rinsing method of Tomoharu et al. as above includes all that is recited in claim 37 except for the material of the article to be cleaned.

With regard to the claimed material of the article to be cleaned, it would have been obvious to one having ordinary skill in the art at the time the invention was made to choose the article with any kind of material, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. In re Leshin, 125 USPQ 416. For product by process claim 38, see optical lens 2.

7. Claims 34-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kamiya (U.S. Pat. 4,989,031) in view of Mukai (U.S. Pat. 5,120,394) and Kuzumoto et al. (U. S. Pat. 6,616,773).

Kamiya shows a rinsing method comprising providing a first container I, a light emitting unit 1, 11, 12 disposed inside the first container I for emitting laser lights, a second container II, III disposed inside the first container I and being adapted to accommodate an article 2, 4 to be rinsed, the second container II, III having a clearance through the first container I (see Fig. 1), a first gas supplying means 31, 32 for introducing a rinsing gas into the second container II, III to maintain an ambience of the second container which ambience is different from that of the first container and also to keep an internal pressure higher than that of the first container I (col. 4, lines 18-25). The internal pressure in the second container II, III is higher than the first container I, (the second container is pressurized while the article 2, 4 under irradiation of ultraviolet rays during operation during operation). The oxygen gas is exhausted in the first container I so that a nitrogen containing ambience remains in each of the first and second containers (see Col. 6, lines 7-30). During the operation, there will be some N₂ in the ambience. It should be noted that N₂ does exist in ambience or atmosphere. However, Kamiya does not show irradiating the article with ultraviolet rays and introducing a nitrogen gas into the second

container and exhausting the oxygen gas or ozone gas in the second container to exchange an ambience of the second container. Mukai teaches a concept of using ultraviolet light generator for irradiating a laser ray (wavelength: 193 nm) over the surface of substrate 11 (col. 5, lines 6-9) and introducing N₂ gas 8, 9 into the inner (second) container. Kuzumoto et al. teach a concept of introducing a nitrogen gas into the second container 1 and exhausting the oxygen gas or ozone gas in the second container to exchange an ambience of the second container (col. 2, lines 33-36 and Fig. 1). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify method of Kamiya to include a step of supplying ultraviolet rays as taught by Mukai and a step of introducing a nitrogen gas to the second container for replacing the oxygen gas or ozone gas in the second as taught by Kuzumoto et al. in order to more efficiently clean the articles inside the second container. With regard to the claimed material of the article to be cleaned, it would have been obvious to one having ordinary skill in the art at the time the invention was made to choose the article with any kind of material, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. In re Leshin, 125 USPQ 416.

Response to Arguments

8. Applicant's arguments filed on **11/20/08** have been carefully considered. However, the arguments are not persuasive to overcome the rejection. First, claims presented still fail to define over the prior art references. Second, regarding the 35 USC 103 rejections, since each and every claimed process step is shown by the prior art references, therefore, it would have been obvious

to one skilled in the art to modify method of Kamiya to include a step of supplying ultraviolet rays as taught by Mukai and a step of introducing a nitrogen gas to the second container for replacing the oxygen gas or ozone gas in the second as taught by Kuzumoto et al. in order to more efficiently clean the articles inside the second container. In view of the combined teaching of the prior art references, one skilled in the art would have found it to be obvious to combine because the results would have been predictable (see KSR International Co. v. Teleflex, Inc. 82 USPQ 2d 1385 (2007)). Third, on pages 6-9, the applicant argues that there is no teaching of introduction of nitrogen ambience in both first and second containers. The examiner disagrees because nitrogen ambience is nothing more than an ambience with nitrogen. Therefore, the examiner has applied the prior art references against the broad claims with their broadest reasonable interpretation. Does the applicant intend to claim nitrogen gas only rather than nitrogen ambience? Fourth, it is noted that the applicant has not commented on the 102 rejections of the broad product by process claim 38. Therefore, this constitutes acquiesce to the rejection. Cancellation of the broad product by process claim 38 is required. This Office action is made final. The new ground of rejection, if any, is necessitated by the amendment to claim 34 (see, lines 7-8 and 13-16 of claim 34).

Conclusion

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jiping Lu whose telephone number is 571 272 4878. The examiner can normally be reached on Monday-Friday, 9:00 AM - 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, KENNETH RINEHART can be reached on 571-272-4881. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jiping Lu/
Primary Examiner
Art Unit 3743

J. L.